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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/417,990	10/13/1999	CHRISTOPHER J. LOVETT	MSI-383US	8254

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EXAMINER	
QUELER, ADAM M	
ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 10/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/417,990	LOVETT ET AL.	
	Examiner	Art Unit	
	Adam M. Queler	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 August 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *30-39* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *30-39* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: Amendment filed 01/27/2005.

2. Claims 30-39 are pending in the case. Claims 30, 34, and 39 are independent claims.

Response to Declaration - 37 CFR 1.131

3. The declaration filed on 01/27/2005 under 37 CFR 1.131 has been considered but is ineffective to overcome the Dougherty reference.

4. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Dougherty reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. MPEPE § 715.07 states "[A] declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131."

5. Regarding the "Push Model XML / Node Factory" exhibit, hereinafter Exhibit A, the exhibit is insufficient to demonstrate the correctness of the conclusions in the Exhibit. Firstly, the Exhibit states that none of the validation support is implemented (p. 1). Page 7 merely recites flags that are settable for validation which is not implemented. Page 14 a few elements to be used by validation but again no implementation. Also this page talks about converting DTD schemas to XML-Data schemas, which is the **complete opposite of the claimed "converting."** Pages 19-20 are merely error classes and do not add any more insight into conception of the claimed subject matter. The declaration points to several pages for proof of conception of validation. MPEP § 2138.04 states:

> Conception has been defined as "the complete performance of the mental part of the inventive act" and it is "the formation in the mind of the inventor of a definite and permanent idea of the complete and operative invention as it is thereafter to be applied in practice...." *Townsend v. Smith*, 36 F.2d 292, 295, 4 USPQ 269, 271 (CCPA 1930). "[C]onception is established when the invention is made sufficiently clear to enable one skilled in the art to reduce it to practice without the exercise of extensive experimentation or the exercise of inventive skill." *Hiatt v. Ziegler*, 179 USPQ 757, 763 (Bd. Pat. Inter. 1973). Conception has also been defined as a disclosure of an invention which enables one skilled in the art to reduce the invention to a practical form without "exercise of the inventive faculty." *Gunter v. Stream*, 573 F.2d 77, 197 USPQ 482 (CCPA 1978).

The near mentioning of admittedly unimplemented abstract variables does not appear to be a "definite and permanent idea of the complete and operative invention as it is thereafter to be applied in practice." Nor does enable one skilled in the art to reduce the invention to a practical form, without exercise of the inventive faculty. Rather, it seems like an admission that a solution was not found yet.

The declaration also points to the support for parsing, but not to the claimed subject matter of parsing into schema elements and data elements. The alleged "converting" on pages 10-13 appear to be mere creation of a node, and finding a specific element, neither of which prove conception of the claimed subject matter.

6. Regarding the "XML Schema Patent Disclosure" exhibit, hereinafter Exhibit B, no exhibit was attached to the current Declaration. The Office assumes the Declaration is referring to the previous filed exhibit, filed 01/27/2005, which was deemed insufficient in the Office Action of 02/18/2005. As no new arguments or declarations are made in regard to Exhibit B, the insufficiency will be repeated: The exhibit is dated 7/7/1999. Therefore, absent further evidence, the declaration is only sufficient to prove conception before 7/7/1999, which does not antedate the Dougherty reference.

Claim Rejections - 35 USC § 103

7. Claims 30-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dougherty, "XML Authority Ends Waiting Games for Schema Developers," and further in view of "XML Authority Product Overview" found at `http://www.extensibility.com/xml_authority/xml_ath_specs.htm` (archived 5/8/1999), hereinafter Extensibility, and further in view Applicants Admitted Prior Art.

Regarding independent claim 30, Dougherty teaches converting schema elements into DTD's. Dougherty discloses an editor capable of saving schemas as DTD's (p. 1, para. 4). Dougherty taken as a whole generally describes a product that serves an editor, which allows the user to be able to commit one of the many schema types, while maintaining compatibility with others.

Dougherty does not teach parsing the document into schema and data elements. Extensibility teaches, "XML Authority imports schema information residing in existing data structures and documents," including XML documents (p. 2). In order to import the schema information, and since XML documents are text documents, inherently they must be parsed into data and schema elements. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Dougherty and Extensibility, thereby loading schemas and outputting DTD's, for the purpose of not limiting the user to any particular schema implementation (Dougherty, p. 1, para. 4 and Extensibility, p. 3, "Diverse..."). Additionally, they are both descriptions of the same product.

Applicant admits that DTDs were used to validate data elements (p. 6, ll. 17-21). Applicant also admits that, in prior art systems, after validation the validation node-factory passes the objects to the tree builder node-factory (p. 6, 17-21). It would have been obvious to

one of ordinary skill in the art at the time of the invention to combine the conversion of Extensibility with the prior art validation system of Applicant's Admitted Prior Art since a DTD's primary use was to validate XML documents (Dougherty, p.2, para. 1), it would have been logical to use a system that was known in the art at the time of the invention to facilitate the validation. It would have been further obvious to use this approach since it would not limit the user to any particular schema implementation (Dougherty, p. 1, para. 4 and Extensibility, p. 3, "Diverse...").

Regarding dependent claim 33, the computer readable medium for performing the method of claim 1 is rejected under the same rationale.

Regarding independent claim 34, the architecture for performing the method of claim 1 is rejected under the same rationale.

Regarding dependent claim 36, the computer readable medium for performing the method of claim 1 is rejected under the same rationale.

Regarding dependent claim 37, the client/server for performing the method of claim 14 is rejected under the same rationale.

Regarding independent claim 39, the system for performing the method of claim 1 is rejected under the same rationale.

Regarding dependent claim 38, Dougherty and Extensibility do not explicitly disclose a node factory but Dougherty does teach that DTD's are used for validation (Dougherty, p.2, para. 1). Applicant admits it was known in the prior art to uses a validation node factory to evaluate whether the data elements comply with constraints set forth in the DTD objects (p. 6, 12-13). It would have been obvious to one of ordinary skill in the art at the time of the invention to

combine the conversion of Dougherty and Extensibility with the prior art validation system of Applicant's Admitted Prior Art since a DTD's primary use was to validate XML documents (Dougherty, p.2, para. 1), it would have been logical to use a system that was known in the art at the time of the invention to facilitate the validation. It would have been further obvious to use this approach since it would not limit the user to any particular schema implementation (Dougherty, p. 1, para. 4 and Extensibility, p. 3, "Diverse...").

8. Claims 32 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dougherty, Extensibility, and Applicant's Admitted Prior Art as applied to claims 30 and 34 above, and further in view of Hickman et al. (USPN 6564252—filed 3/11/1999).

Regarding dependent claims 32 and 35, Extensibility is silent as to tables. Hickman et al. (Hickman) discloses tables of schemas (col. 8, ll. 65-67). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Hickman, **Extensibility** and Applicant's Admitted Prior Art in order to provide a place to store the schemas.

9. **Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dougherty, Extensibility, and Applicant's Admitted Prior Art as applied to claim 30 above, and further in view of "Application Programming Interface" found at** `http://www.coffeycountyks.org/Terms/2461HTML-126.html` **(6/7/1999) hereinafter Coffey.**

Regarding dependent claim(s) 31, Dougherty and Extensibility teach converting from schema to DTD as explained in claim 1. Inherent in converting is constructing the DTD objects. Neither Extensibility nor Dougherty teach API's. Coffey teaches an API. It would have been obvious to

one of ordinary skill in the art at the time of the invention to call any number of API's, because API's are quicker and easier then developing program from scratch (Coffey).

Response to Arguments

10. Applicant's arguments filed 08/18/2005 have been fully considered but they are not persuasive.

11. The Applicants arguments have been addressed in the discussion of the §1.131 Declaration above.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam M. Queler whose telephone number is (571) 272-4140. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AQ

William L. Bashore

WILLIAM BASHORE
PRIMARY EXAMINER

10/23/2005